APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,512	11/16/2001	Howard Francis Willers	01-110	7394

7590 12/22/2005	**EXAMINER**
HOWARD WILLERS	DURAN, ARTHUR D
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SANJOSE, CA 95124	

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 12/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/991,512	WILLERS ET AL.
	Examiner	**Art Unit**
	Arthur Duran	3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>09 November 2005</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-30</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-30</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   Claims 1-30 have been examined.

Response to Amendment

2.   The Amendment filed on 11/9/05 is sufficient to overcome the prior rejection. A new

reference has been added to the 35 USC 103 rejection.

Continued Examination Under 37 CFR 1.114

3.   A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR

1.17(e), was filed in this application after final rejection. Since this application is eligible for continued

examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the

finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's

submission filed on 11/9/05 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

4.   Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerace

(5,848,396) in view of Angles (5,933,811) in view of Nason (6,630,943) in view of Goldhaber

(5,794,210) in view of Gvily (2002/0005867).

      Claim 1, 11, 19, 20: Gerace discloses a method, medium, system of providing a system

for selective communication of promotional information among a plurality of sponsors and a

plurality of users over a computer network comprising the acts of:

a)   enrolling a plurality of sponsors, the act of enrolling each sponsor comprising the act of

assigning the sponsor with at least one group of customization parameters which are sufficient to

uniquely define the look and feel of a value portal skin (col 2, line 60-col, lines 10; col 6, lines

22-40; col 20, lines 10-25; col 18, lines 26-30);

b)   providing a sponsor server information in computer useable form to at least one of the

plurality of sponsors (col 18, lines 26-35), wherein the sponsor server software executing on a

sponsor server comprises functionality for communicating messages with a client software on a

user's computer over the computer network according to a special communication protocol (col

7, lines 47-56; col 7, lines 60-65; col 9, lines 39-45);

c)   providing the client information to a plurality of users in machine useable form (col 13,

lines 35-40; col 6, lines 22-35), each of said plurality of users having a user's computer capable

of using the client software and having access to the computer network, wherein each user's

computer operates under an operating system having a graphical user interface (col 6, lines 12-

22; col 3, lines 39-54; Fig. 1), and wherein the client software when executing on a user's

computer comprises:

i)   functionality for installing a value portal on the user's computer, the look and feel of the value portal capable of being defined by any of the unique group of customization parameters defining a value portal skin which have been assigned to each of the plurality of categories (col 11, lines 24-56; col 6, lines 23-40),

ii)   functionality for providing access to a plurality of additional utilitarian application programs through said value portal (col 1, lines 10-14; col 2, line 60-col 3, line 3; col 22, lines 10-25),

iii)   a system database capable of storing a plurality of groups of customization parameters, said system database comprising at least one group of customization parameters therein corresponding to at least one sponsor of said plurality of sponsors (col 19, lines 18-31; col 20, lines 19-25; col 11, lines 24-56; col 6, lines 23-40),

iv)   functionality for choosing which group of customization parameters from the plurality of groups of customization parameters in the system database will be used to define the look and feel of the value portal (col 12, lines 49-56; col 20, lines 10-19; col 11, lines 24-56; col 6, lines 23-40),

v)   functionality for exchanging messages with at least one sponsor through communication with a sponsor server operated by the sponsor server software, according to the special communication protocol (col 7, lines 47-56; col 7, lines 60-65; col 9, lines 39-45),

vi)   functionality for displaying messages on the value portal (col 7, lines 47-56; col 7, lines 60-65; col 9, lines 39-45), and

vii) functionality for registering a user (col 4, lines 55-65) with a sponsor server (col 14, lines 30-36; col 22, lines 15-20; col 11, lines 24-56; col 6, lines 23-40) and executing the sponsor software (col 18, lines 1-10).

Gerace further discloses software on the client and software on the sponsor server (col 1, lines 47-50; col 18, lines 26-30).

Gerace further discloses multiple sponsors (col 14, lines 30-36; col 22, lines 15-20; col 18, lines 25-30). Gerace further discloses multiple categories of content (col 6, lines 27-35), multiple content providers (col 1, lines 14-30), and that a content provider can be a sponsor or a provider of content or a provider of advertising (col 2, lines 62-66).

Therefore, Gerace implies that there are multiple content provider sponsors such that different categories of content can be supplied by different sponsors.

Gerace does note explicitly disclose that there are multiple content provider sponsors such that different categories of content can be supplied by different sponsors.

Gerace does not explicitly disclose that the software can be run locally or on the client.

Gerace does not explicitly disclose that the sponsor can run sponsor software on the server.

However, Angles discloses that there are multiple content provider sponsors such that different categories of content can be supplied by different sponsors (Fig. 2).

Angles further discloses that the software can be run locally or on the client (col 3, lines 24-29; Fig. 11, item 12) and that client run software can be faster (col 12, lines 2-11).

Angles further discloses that the sponsor can run sponsor software on the server (col 12, lines 40-50).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Angles special software located on the client or on the sponsor server to Gerace's user with software or sponsor with software. One would have been motivated to do this in order to allow greater flexibility and performance in various hardware and software configurations.

Gerace further discloses that numerous aspects of presentation and format of the user interface can be controlled and optimized (col 6, lines 13-21; col 5, lines 19-26).

Gerace does note explicitly disclose that the user interface can utilize a task bar.

However, Nason discloses the utilization of a customized portal (col 17, lines 5-13; col 17, lines 35-38; col 17, line 65-col 18, line 29) and the utilization of a task bar (Fig. 15; col 4, lines 45-50)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Nason's task bar to Gerace's customizable interface. One would have been motivated to do this in order to provide further customization with an interface format that many users are familiar with and find convenient.

Additionally, Gerace further discloses the user selecting categories of content of interest and the user indicating categories to display content for (col 6, lines 21-41; col 11, lines 24-35; col 11, lines 45-56; col 7, lines 52-57).

Goldhaber discloses that the user can indicate that only marketing messages from certain categories of sponsors or advertisers will be received by the user:

"(43) The demographic profiles can be constructed through interest questionnaires that the consumer completes when subscribing to the service, and also through electronic tracking of

his/her usage of the service (and other habits). Thus, the profiles can be dynamic, evolving with the customer's transaction history. A customer can choose to exclude any transaction (e.g., viewing of certain material or purchasing of certain products) from his profile. Profiles can also be interactive in that a customer may edit his profile at any time to add or delete interest features, and to delete any transaction records. Thus, for example, the customer can delete historical transaction entries evidencing her purchase of an "adult" film if desired. Similarly, the customer can change her profile to express interest in seeing certain types of automobile advertisements, and then, after she has selected and purchased a new car, delete those profile entries (col 6, lines 45-61);

(93) Referring once again to FIG. 11A, the consumer's software agent 110 may also, if desired, initiate the above-described matching process whenever the consumer's interest profile 124 changes (FIG. 11A, block 190). In this example, system 100 will track the consumer's activities and elaborate the consumer's profile 124 automatically. In addition, system 100 in this example permits the consumer to view and edit a plain-language representation of her profile 124 at any time, and add anything to it or delete anything from it. Thus, for example, if the consumer begins looking for a new car, she may edit her profile 124 to add an interest about certain types or categories of automobiles. Such a change in the consumer's profile 124 may cause software agent to re-index the consumer's profile 124 (FIG. I A, block 192) and a new scan for matching ads (FIG. 11A, block 194)" (col 17, line 64-col 18, line 12).

Note that in Goldhaber that when the user indicates types or categories of automobiles of interest that the user is choosing which sponsors to receiving marketing messages from. For example, the user can choose to receive only ads from automobile marketers, or ads from

minivan automobile marketers, or ads from Toyota automobile marketers. Hence, Goldhaber

discloses the user chooses the sponsors to receive marketing messages from. Goldhaber

discloses that the user can choose a wide variety of criteria for preventing the reception of or

indicating an interest in receiving sponsor content.

Therefore, it would have been obvious to one having ordinary skill in the art at the time

the invention was made to add Goldhaber's user choosing which sponsors to receive marketing

messages from to Gerace's user indicating categories of content of interest. One would have

been motivated to do this in order to provide the user with further customization as to the type of

content the user is interested in.

Additionally, Gerace does not explicitly disclose multiple sponsors where the user selects

the sponsor.

However, Gvily discloses that the user may modify the customization parameters offered

to the user in relation to the presentation of messages and information received from a sponsor

authorized by the user; and, to provide a capability of each user to individually design the look

and feel of each value portal associated with each sponsor selected by the user. Gvily further

discloses that a user is invited and enabled to explicitly choose and affect via a collaborative

design process the presentation modalities of information generated and assigned for delivery to

the user by entities, i.e., sponsors; and that the users 1) chooses sponsors with whom the user

shall engage in an extended relationship of sharing and selecting information; and 2) instantiate a

collaborative design process with both the sponsor and the author(s) of each combination of

preset customization variables to substantively enhance the user experience as both implicitly

and explicitly directed by the user.

Gvily discloses these features a the following citations (Fig. 1; Fig. 3; Fig. 3, 'Visit Our

Sponsor'; Fig. 5; Fig. 5, 'Sponsored By'; and below):

"[0006] A portal operator might set up an HTTP server or HTTP server farm (the

"portal server") to serve requests from clients seeking information provided by the portal

operators. The HTTP server is often referred to as the portal operator's "website" because a

browser (or other HTTP client) appears to "go" to a new location in the Web when the URL for

the portal operator's HTTP server is specified. Thus, the act referred to as "going to a website"

does not involve any movement per se, other than a change of focus of the HTTP client

and a display of the HTML code representing that website.

[0007] The portal operator might maintain a set of preferences at the portal server for

each user that has set up an account with the portal operator. Thus, if the portal provider allows

the user to select or deselect categories of information, such as stock quotes, news and weather,

a user that is not interested in the weather could set preferences to indicate that when that user

requests a portal page from the portal server and the portal server has identified the user, the

portal server should serve an HTML page that contains current stock quotes and news, but not

weather. Since the page served by the portal server is customized to the user when the portal

server has identified the user, the page served is often referred to as that user's portal page.

[0008] Portal servers allow for user customization based on preferences, but the typical

portal operator only allows a user to build the user's portal page from components ("snippets")

made available by that portal operator. Furthermore, the data used to populate the snippets is

typically limited to the data ("content") the portal operator makes available. For example, a

user might set up the user's portal page to show the weather in San Francisco and Dallas and the

news related to baseball, if the portal operator provided a weather snippet and a sports news

snippet. The values for the weather data and the news items presented in those snippets are the

values and items provided by that portal operator.

[0009] Because each portal operator has snippets and content that is specific to that portal

operator, many users maintain several portal pages at several portal websites. Thus, a single

user might have dozens of customized portal pages on dozens of different portal websites, even

though the user is only interested in selected content from each of those portal websites.

[0043] Using aspects of the present invention, a browser user can select portions or all of

an HTML page being browsed and construct a portal snippet from the selection. The portal

snippet is typically stored as a preference for that user, so that the user's custom portal page

includes the content and layout of the portal snippet. It is then saved as part of the user settings

for the portal. The next time the user's home page is opened, that snippet is there for viewing.

Further, the user can define a test to perform against a snippet to provide notification of when a

defined change in the snippet occurs. In some embodiments, the selection process can be

generalized to allow selection of any hierarchical information".

Therefore, it would have been obvious to one having ordinary skill in the art at the time

the invention was made to add Gvily's user selected sponsor(s) and portal customized to a user

based on user preferences to Gerace presenting a customized portal to a user, tracking user

preferences, and Gerace's multiple sponsors. One would have been motivated to do this in order

to allow the user to access a variety of portals as preferred by the user.

Claim 2, 21: Gerace, Angles, and Nason and Goldhaber and Gvily disclose the method, system of claim 1, 21. Gerace further discloses that the act of providing at least one authentication server operating with an authentication server software accessible to the computer network, said authentication server being capable of authenticating a communication between one of said plurality of user's computers operating the client software and a sponsor server operating the sponsor server software communicating according to the special communication protocol (col 18, lines 35-40; col 13, lines 60-65; col 17, lines 17-25).

Claim 3, 4, 12, 13, 24: Gerace, Angles, and Nason and Goldhaber and Gvily disclose the system, medium, system of claim 2, 11, 23. Gerace further discloses that the plurality of additional utilitarian programs are accessible only when the client software program is operating (col 4, lines 55-60), and the functionality of the plurality of utilitarian programs is invariant to selection of which group of customization parameters defines the look and feel of a value portal or the value portal skin (col 1, lines 10-14; col 2, line 60-col 3, line 3; col 22, lines 10-25).

Gerace further implies that regular use of the client software is encouraged (col 4, lines 25-30; col 4, lines 15-18).

Therefore, it would be obvious to Gerace to encourage the user to utilize the system. Gerace would be motivated to do this in order to better profile a user because the more a user utilizes the system the better the user can be profiled.

Claim 5, 14: Gerace, Angles, and Nason and Goldhaber and Gvily disclose the method, medium of claim 4, 13. Gerace further discloses that the client software further comprises functionality for periodically accessing at least one sponsor server to obtain messages according to the special communication protocol (col 7, lines 47-56; col 7, lines 60-65; col 9, lines 39-45).

Claim 6, 15, 25: Gerace, Angles, and Nason and Goldhaber and Gvily disclose the method, medium, system of claim 5, 14, 24. Gerace further discloses that the client software further comprises functionality for optionally updating the client software program and system database on a user's computer during a communication according to the special message protocol (col 13, lines 36-46; col 13, lines 62-col 14, line 4).

Gerace further discloses that the communication session is with a sponsor server (col 13, lines 60-65).

Claim 7, 8, 16, 17, 27, 28: Gerace, Angles, and Nason and Goldhaber and Gvily disclose the method, medium, system of claim 6, 15, 25.

Gerace further discloses that numerous aspects of presenation and format of the user interface can be controlled and optimized (col 6, lines 13-21; col 5, lines 19-26).

Gerace does not explicitly disclose that the value portal is installed overlaying the task bar on the graphical user interface, or that the value portal is installed adjacent to the task bar on the graphical user interface.

However, Nason discloses the utilization of a widely customized portal in terms of format presentation and the utilization of a task bar (Fig. 15; Fig. 3; Figs 16-21; col 4, lines 45-50; col 17, lines 5-13; col 17, lines 35-38; col 17, line 65-col 18, line 29))

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Nason's task bar to Gerace's customizable interface. One would have been motivated to do this in order to provide further customization with an interface format that many users are familiar with and find convenient.

Claim 9, 18, 29: Gerace, Angles, and Nason and Goldhaber and Gvily disclose the method, medium, system of claim 6, 15, 25. Gerace further discloses that the client software launches an application program with the value portal included thereon (col 22, lines 5-25; col 36, lines 54-59).

Claim 10, 26, 30: Gerace, Angles, and Nason and Goldhaber and Gvily disclose the method, system of claim 6, 25. Gerace further discloses that the client software, the sponsor server software, and the special message protocol contain functionality to enable a first user to exchange a message with a second user through a common sponsor server which both the first user and the second user periodically exchange messages (col 10, lines 25-39).

Gerace further discloses utilizing the special communications protocol (col 1, lines 44-48).

Claim 22: Gerace, Angles, and Nason and Goldhaber and Gvily disclose the system of claim 21 wherein the computer network is the Internet (col 3, lines 50-53).

Claim 23: Gerace, Angles, and Nason and Goldhaber and Gvily disclose the system of claim 22. Gerace further discloses that the at least one sponsor server comprises a plurality of sponsor servers which are each operated by at least one sponsor (Fig. 1; col 1, lines 45-49; col 3, lines 48-49).

Response to Arguments

Applicant's arguments with respect to claims 1-30 have been considered but are moot in view of the new ground(s) of rejection.

In Applicant's Amendment dated 11/9/05, Applicant states on page 17 and page 23,

respectively, that the following features are not disclosed by the prior art:

"the user may modify the customization parameters offered to the user in relation to the

presentation of messages and information received from a sponsor authorized by the user; and, to

provide a capability of each user to individually design the look and feel of each value portal

associated with each sponsor selected by the user"; and,

"that a user is invited and enabled to explicitly choose and affect via a collaborative

design process the presentation modalities of information generated and assigned for delivery to

the user by entities, i.e., sponsors; and that the users 1) chooses sponsors with whom the user

shall engage in an extended relationship of sharing and selecting information; and 2) instantiate a

collaborative design process with both the sponsor and the author(s) of each combination of

preset customization variables to substantively enhance the user experience as both implicitly

and explicitly directed by the user".

Please note the section added above in the rejection of the Independent claims that starts

with, "Additionally, Gerace does not explicitly disclose multiple sponsors where the user selects

the sponsor. However, Gvily discloses that the user may modify. . ." thru to the rejection of the

independent claims to see how the combination of the prior art renders obvious the features of

the Applicant's claims.

Examiner further notes that it is the Applicant's claims as stated in the Applicant's claims

that are being rejected with the prior art. Also, although the claims are interpreted in light of the

specification, limitations from the specification are not read into the claims. See *In re Van*

Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). And, Examiner notes that claims are

given their broadest reasonable construction. See *In re Hyatt*, 211 F.3d 1367, 54 USPQ2d 1664

(Fed. Cir. 2000).

Examiner notes that while specific references were made to the prior art, it is actually

also the prior art in its entirety and the combination of the prior art in its entirety that is being

referred to. Also, one cannot show nonobviousness by attacking references individually where

the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

The following prior art made of record and not relied upon is considered pertinent to

applicant's disclosure:

a) Bhatia (20020038386) discloses a portal with customizable features.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Arthur Duran whose telephone number is (571) 272-6718. The

examiner can normally be reached on Mon- Fri, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Arthur Duran
Patent Examiner
12/7/05